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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,919	08/07/2001	Michael David Bell	CM2034	1792

27752 7590 07/08/2004

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,919

Applicant(s)

BELL ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Claims 1-13 are pending.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 3/23/04 to the rejection of claims 1-13 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

It is respectfully pointed out that instant claim 13 depends on itself. The Examiner respectfully requests that Applicant correct this mistake in the next response. It appears that instant claim 13 should depend on instant claim 12.

103 Rejection Maintained

The rejection of claims 1-13 under 35 U.S.C. 103(a) as being unpatentable over Shana (WO 94/03150) in view of Ilardi et al. (6,322,799) and in view of the Handbook of Cosmetic Science and Technology is MAINTAINED for the reasons set forth in the Office Action mailed 10/23/03, and those found below.

Applicant argues, "Shana's is entitle 'Washing Composition". Such compositions are specific to compositions formulated to be washed off the skin. For this reason the compositions are different from the leave-on compositions of the present invention". This argument is not persuasive. The Examiner respectfully points out that Applicant is argument limitations in the preamble and the compositions intended use. First, it is respectfully pointed out that, the recitation "leave on cosmetic. . .suitable for topical application to the skin" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for

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completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Second, it is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant argues, “Not only are the levels of surfactant different, but the sugar based surfactants taught in Shana’s have shorter alkyl chains for enhancing foaming”. This argument is not persuasive. First, it is respectfully pointed out that the rejection is not over Shana alone, but over the combination of Shana and Ilardi, wherein Ilardi teaches the additional surfactants. Second, it is respectfully pointed out that Shana teach sugar based surfactants having an alkyl chain length of C5-C20, which encompasses the chain length recited in the instant claims.

Applicant argues, “Applicants assert that such a composition would have been outside Shana’s disclose and certainly could not function as a washing composition, since 4% surfactant would not be sufficient to produce acceptable cleansing”. This argument is not persuasive. First, it is respectfully pointed out that the compositions of Shana additionally comprising cationic polymers, which can function as surfactants. Second, it is respectfully pointed out that the Shana reference teaches their sugar based surfactants as comprising 1% of their compositions. It is

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respectfully pointed out that a teaching is a teaching, and that Applicant has not provided any sort of results to rebut this teaching in Shana.

Applicant argues, “while alkyl polysaccharide surfactants are listed in the Shana’s reference, there would be no motivation to substitute these compounds into the Ilardi compositions, nor to raise the level of surfactants in Shana’s based on the disclosure of Ilardi”. This argument is not persuasive. First, it is respectfully pointed out that Applicant has mischaracterized the instant rejection. In no place, does the instant rejection suggest substituting these compounds into the Ilardi compositions. Furthermore, Ilardi is not relied upon to raise the level of the sugar based surfactants in Shana, as Shana already teaches that the sugar based surfactants can comprise 1% of the composition. Ilardi further supports the fact, that it is established in the art to vary the amount of sugar based surfactants in washing compositions.

Applicant asks, “Would combining the disclosure of a washing composition and a reference requiring mixtures of alpha hydroxyl acid esters and 9-90% surfactants, not be more likely to produce a washing composition according to Shana’s which also contains the alpha hydroxyl esters?”. This argument is not persuasive. It is respectfully pointed out that the instant transitional phrase, i.e., “comprising”, is open-ended and does not exclude the inclusion of additional ingredients. For this reason alone, Applicant’s argument is moot.

Applicant asks, “Would the combined Shana’s, Ilardi, and ‘Handbook. . .disclosures suggests a successful attempt, in the specific claimed compositions of the instant inventions, at using of small amount of about 0.01% to about 1% of C8 to C24 mono, -di, and-tri acyl sugar esters to improve stability and skin feel?”. This argument is not persuasive. First, this argument is not commensurate in scope with the instant claims, as the instant claims are not directed

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toward improving stability and skin feel, and Applicant has provided no unexpected results to substantiate this statement. Second, as pointed out above, Shana already teaches that the sugar based surfactants can comprise 1% of the composition.

Applicant argues, “while polyhydric alcohols may be optional in the references, there is no inclusion of these materials nor contemplation of the range in which they are used in the references”. This argument is not persuasive. The Examiner is confused as to how Applicant can make such an argument, as the instant rejection clearly describes an example of Shana, the primary reference, of a composition comprising 10% glycerol, a polyhydric alcohol.

Applicant argues, “the instant composition is a leave-on skin care composition, improved lathering and a rich foam are not desirable features in a leave on composition”. This argument is not persuasive. In response to applicant's arguments, the recitation “leave on cosmetic” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is additionally, respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in

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a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

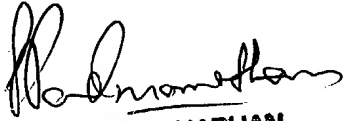
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER